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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND BAZIN and ERIC DOUBLET

Appeal 2010-004376
Application 09/725,048
Technology Center 3700

Before: KEN B. BARRETT, PHILLIP J. KAUFFMAN, and
WILLIAM V. SAINDON, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 4, 6, 25-48, 59, 61, and 62. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

THE INVENTION

Appellants' claimed invention "relates to a process for acquiring scanned image data relating to an external body portion and/or a product applied thereto, wherein the process involves the use of a transfer member." Spec. 1:3-5. Independent claim 4, reproduced below, is illustrative of the claimed subject matter

4. A process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, the process comprising:

placing a transfer member in contact with an external portion of an individual so as to obtain a transfer image on the transfer member,

wherein the transfer image is present on the transfer member after the transfer member and the external portion are out of contact with one another,

wherein the transfer image is not a fingerprint or fingerprints, and

wherein the external portion that the transfer member is placed in contact with does not include a tooth or teeth; and

scanning the transfer image with an optical image scanner to obtain scanned image data for an image representative of at least one characteristic of

the external body portion, and/or

at least one product applied to the external body portion,

wherein the transfer member is placed in direct contact with an external body portion including a cosmetic product applied thereto, and wherein the image of the scanned image data is representative of at least one characteristic of the cosmetic product.

EVIDENCE RELIED UPON AND REJECTIONS¹

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Stoughton	US 3,969,516	Jul. 13, 1976
Groh	US 5,343,536	Aug. 30, 1994
Murad	US 6,296,880 B1	Oct. 2, 2001
Sheng	US 6,801,343 B1	Oct. 5, 2004

Joseph C. Kvedar, et al., *Teledermatology in a Capitated Delivery System Using Distributed Information Architecture: Design and Development*, Telemedicine Journal, vol. 5 (Nov. 4, 1999), pp. 357-366.

Appellants seek review of the following rejections:

1. Claims 4, 6, and 61-62 under 35 U.S.C. § 103(a) as unpatentable over Groh, and Stoughton.
2. Claims 37, 46, and 47 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, and Kvedar
3. Claim 59 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, Kvedar, and Murad.
4. Claim 48 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, and Sheng.
5. Claims 25-36 and 38-45 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, Kvedar, and Sheng.

¹ The Examiner's Answer contains these five new grounds of rejection. Ans. 3-4. The Examiner withdrew the grounds of rejection contained in the Office Action that is the subject of this appeal, with the exception of the rejection of claims 25-36 and 38-45 as obvious over Groh, Kvedar, and Sheng. *Id.*; *see also* Office Action dated Dec. 23, 2008, pp. 9-10. The new grounds of rejection reject these claims over Groh, Stoughton, Kvedar, and Sheng. Ans. 10-14. Therefore, we conclude the Examiner inadvertently failed to withdraw the rejection of claims 25-26 and 38-45 over Groh, Kvedar, and Sheng and treat the rejection as withdrawn.

OPINION

Claims 4, 6, and 61-62 over Groh and Stoughton

Claims 4 and 6

Appellants argue claims 4 and 6 as a group, and we select claim 4 as representative. Reply Br. 6-9; *see* 37 C.F.R. § 41.37(c)(1)(vii)(2011).

The Examiner found that Groh discloses the method of claim 4, except that, “Groh does not explicitly teach the application of the transfer member in contact with a cosmetic product applied to an external body portion.” Ans. 6. The Examiner found that Stoughton discloses the use of compositions applied to and absorbed by the skin for treatment of acne. Ans. 6-7. The Examiner concluded that it would have been obvious “to apply a cosmetic product (like the acne treatment composition of S[t]oughton) upon the skin, wherein the application of this product would result in the capturing of facial characteristics (comedones) including the cosmetic product worn by the patient, as the Appellant has done, for the purpose of testing the testing the efficacy of the acne treatment formulation.”² Ans. 7.

Appellants argue that the proposed combination does not disclose or render obvious the step of “[a] transfer member...placed in direct contact with an external body portion including a cosmetic product applied thereto,” as recited in independent claim 4.” Reply Br. 6-9. Specifically, because Stoughton does not disclose that the comedones removed using Stoughton’s technique include any of the composition, Appellants reason that that the proposed combination will not result in the transfer member being placed in

² Comedones are also known as blackheads. Groh, col. 1, l. 32.

direct contact with an external body portion including a cosmetic product applied thereto. Reply Br. 8-9. This reasoning is flawed.

Stoughton removes comedones using an extractor in order to perform a microbiological study on the comedones to determine the concentration of *Corynebacterium acnes* (*C. acnes*) of the comedone material. Stoughton, col. 1, l. 28; col. 3, ll. 3-13. However, the proposed combination does not rely upon Stoughton's extraction method. Rather, the proposed combination uses Groh's technique of applying a thin film of adhesive to the skin, then applying a glass microscopic slide to the film of adhesive, and after the adhesive is set, removing the slide along with a thin layer of skin containing comedones and other materials taken from the skin. Ans. 5-6; *see also* Groh, col. 1, l. 32; col. 2, ll. 37-45. Consequently, Appellants' argument does not address the rejection as articulated by the Examiner.

Accordingly, we sustain the rejection of claims 4 and 6.

Claims 61 and 62

Claims 61 and 62 depend, directly or indirectly, from claim 48, and include the limitation of scanning the transfer image with an optical image scanner. The rejection contains no finding regarding this limitation, and for that reason, we agree with Appellants that this rejection is in error. *See* Ans. 5-7; Reply Br. 10, 21. As such, we cannot sustain the rejection of claims 61 and 62.

Claims 37, 46, and 47 over Groh, Stoughton, and Kvedar

Claim 37

Independent claim 37 is directed to a process of analyzing at least one characteristic of an external body portion and/or at least one product applied to the external body portion, and includes the step of “comparing the displayed image to at least one image formed from image data stored in an image database.”

The Examiner found that the proposed combination of Groh and Stoughton used for claim 4 discloses the method of claim 37 except comparing the displayed image to at least one image formed from image data stored in an image database. Ans. 7-8. The Examiner found that Kvedar discloses comparing images for the purpose of assessing the progress of the patient’s treatment. Ans. 8. The Examiner concluded that it would have been obvious to compare images, as taught by Kvedar, to monitor the progression of the patient’s treatment and determine appropriate care methods. *Id.*

Appellants argue that the proposed combination is not supported by a legitimate rationale because Kvedar discloses reviewing patient histories and images to render an opinion, and nowhere in Kvedar is there any disclosure relating to comparing images for the purpose of assessing a patient’s progress. Reply Br. 11-12. Appellants’ argument is unpersuasive because it mischaracterizes the reference.

Kvedar discloses a teledermatology system utilizing digital images stored on and viewed through a common web server that permits a primary care physician (PCP) to seek a dermatologic consultation electronically by providing a specialist with digital images. Kvedar, Abstract; p. 357, col. 1,

paras. 1-2. Kvedar discloses that when notified of a pending consultation, specialists reviewed patient history and images and rendered an opinion. Kvedar, p. 362, col. 1, para. 2-col. 2. Data is stored in a single location, permitting efficient storage and retrieval of information, including appropriate history and images, as well as measuring outcomes. Kvedar, p. 364, col. 1, para. 1. A person of ordinary skill in the art would understand that measuring of outcomes (a follow-up visit to determine progress of treatment) would involve comparing the original image to a subsequent image. *See* Ans. 8, 16-17; *contra*. Reply Br. 11-12.

Accordingly, we sustain the rejection of claim 37.

Claim 46

Independent claim 46 is directed to a process of evaluating a product applied to an external body portion, and includes the step of viewing a displayed image to analyze at least one characteristic of an external body portion and/or at least one product applied to the external body portion.

Appellants argue that the Examiner fails to provide any legitimate rationale for the proposed combination. Reply Br. 13. Appellants' argument is unpersuasive because it fails to convincingly address the rationale provide by the Examiner, namely, "to monitor the progression of the patient's treatment and determine appropriate care methods." *See* Ans. 8.

Appellants argue that "none of the references discloses or renders *prima facie* obvious '[a] process of evaluating a product applied to an external body portion ...comprising: ... viewing [a] displayed image to analyze ... at least one characteristic [of an external body portion, and/or at least one product applied to the body portion],' as recited in independent

claim 46.” Reply Br. 13. In support of this argument, Appellants assert that each of the references individually do not disclose this step. *Id.* Such an assertion is unconvincing because the rejection is based upon the combined teachings of the references. *See* Ans. 8; *see also In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references).

Accordingly, we sustain the rejection of claim 46.

Claim 47

Appellants argue for the patentability of claim 47 based up its dependence from claim 46, and for the reasons explained in the analysis of claim 46, *supra*, those argument are unconvincing here as well. *See* Reply Br. 14. Appellants also repeat the arguments used against Groh and Stoughton from the rejection of claim 4, and add that Kvedar does not cure these deficiencies. Reply Br. 15. As explained in the analysis of claim 4, *supra*, there are no deficiencies in the proposed combination of Groh and Stoughton for Kvedar to remedy. Accordingly, we sustain the rejection of claim 47.

Claim 59 over Groh, Stoughton, Kvedar, and Murad

Independent claim 59 is directed to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, and includes the step of “analyzing at least one of the external body portion and the transfer member with analysis equipment, wherein the analysis equipment is chosen from one of a corneometer, a dermal torque meter, a PH meter, and a device for measuring hydration of

the skin.” In parity with the claim, the Specification describes that the claimed process could combine both an analysis of one or more images formed from the scanned image data and any other type of analysis for external body portions and/or cosmetic products, such as a corneometer for measuring hydration of the skin. Spec. 25:1-9

The Examiner found that the proposed combination of Groh, Stoughton, and Kvedar used for the rejection of claim 37 also renders obvious the method of claim 59 except for the step relating to the use of analysis equipment. Ans. 9. The Examiner concluded that it would have been obvious to modify the proposed combination of Groh, Stoughton, and Kvedar by adding the use of a corneometer, as taught by Murad, in order to detect the health of the skin in relationship to treatment methods. *Id.*

According to Appellants, “[t]here is no reason an artisan in Groh's field would have looked to Murad to use a corneometer to measure skin hydration at least because it is not used for measuring the number of comedones present in a follicular biopsy slide. Thus, using a corneometer to measure the number of comedones would defeat the principle of operation of Groh's device, which relies on the use of adhesive and slides rather than a corneometer.” Reply Br. 17. In other words, Appellants argue that because Murad's corneometer is not useful for measuring the number of comedones, a person of ordinary skill in the art would add the use of Murad's corneometer to Groh's process. Similarly, Appellants argue that, “because a corneometer is not used for measuring the number of comedones present in a follicular biopsy slide, an artisan in Groh's field would have no reasonable expectation that adding a corneometer to Groh's device would be successful in improving Groh's device for measuring the number of comedones.”

Reply Br. 17-18. Such line of reasoning is unpersuasive because the Examiner's proposed combination does not utilize Murad's corneometer to measure comedones. Rather, the proposed modification supplements Groh's technique by the adding the step of analyzing at least one body portion with analysis equipment (a corneometer) as taught by Murad. Ans. 17-18.

Accordingly, we sustain the rejection of claim 59.

Claim 48 over Groh, Stoughton, and Sheng

Independent claim 48 is directed to a process for acquiring scanned image data relating to an external body portion and/or a product applied to the external body portion, and includes the step of scanning a transfer image with an optical image scanner configured in the form of a scanner for scanning documents.

The Examiner found that the proposed combination of Groh and Stoughton used for the rejection of claim 4 discloses the method of claim 48 to include use of a scanner to scan the image from the transfer member, except that Groh does not disclose that the scanner is a document scanner. Ans. 9-10. The Examiner concluded that it would have been obvious to replace use of Groh's scanner with use of a flatbed scanner for scanning documents, as taught by Sheng, to enable transfer of an image to a computer. *Id.*

Groh's scanner utilizes cross-polarized light when scanning and capturing a digital image of a skin sample because when so lighted, the comedones appear as bright, highly defined objects. *See* Reply Br. 19-20; Groh, col. 2, ll. 54-68. Further, Groh's hardware and software capture the image according to specialized instructions as to what areas of the sample to

evaluate. Reply Br. 20; Groh, col. 4, ll. 47-66. Sheng's document scanner is not disclosed as utilizing cross-polarized light when scanning, nor as utilizing specialized instructions regarding what area of the sample (scanned image) to evaluate. Sheng, *passim*. In light of these disclosures, we agree with Appellants that a person of ordinary skill in the art would not have made the modification proposed by the Examiner. See Reply Br. 19-20.

As such, we cannot sustain the rejection of claim 48.

Claims 25-36 and 38-45 Groh, Stoughton, Kvedar, and Sheng

Independent claims 25 and 38 are similar to independent claim 48 in that they include the step of scanning a transfer image with an optical image scanner configured in the form of a scanner for scanning documents. For the reasons explained in the analysis of claim 48, *supra*, the rejection of independent claims 25 and 38 is also in error.³ See Reply Br. 22-25.

DECISION

We affirm the Examiner's decision to reject claims 4 and 6 under 35 U.S.C. § 103(a) as unpatentable over Groh, and Stoughton.

We reverse the Examiner's decision to reject claims 61 and 62 under 35 U.S.C. § 103(a) as unpatentable over Groh, and Stoughton.

We affirm the Examiner's decision to reject claims 37, 46, and 47 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, and Kvedar.

We affirm the Examiner's decision to reject claim 59 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, Kvedar, and Murad.

³ Kvedar is not relied upon to correct these deficiencies.

We reverse the Examiner's decision to reject claims 48 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, and Sheng.

We reverse the Examiner's decision to reject claims 25-36 and 38-45 under 35 U.S.C. § 103(a) as unpatentable over Groh, Stoughton, Kvedar, and Sheng.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Klh